

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

AERITAS-001

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Application Number

09/690,213

Filed

October 17, 2000

First Named Inventor

Mamdani, Malik

Art Unit

2617

Examiner

Iqbal, Khawar

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

If a fee is due for this submission, please charge Deposit Account No. 50-4001.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/David H. Judson/

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Signature

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Registration number if acting under 37 CFR 1.34 _____

January 19, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☒ *Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	Mamdani, et al
Serial Number	09/690,213
Filing Date:	October 17, 2000
Art Unit:	2617
Examiner:	Iqbal, Khawar
For:	Method and system for facilitation of wireless e-commerce transactions

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

This paper accompanies a notice of appeal.

1. There are material claim elements that are not included in the Examiner's analysis

Independent claim 47 had been previously amended to recite the following subject matter, with emphasis supplied:

“47. ...

at a third time distinct from the first time and the second time and while the wireless transaction remains only partially complete, optically scanning a second transaction code from the visual display of the wireless communication device to complete the wireless transaction, wherein personal bodily access into the physical location or structure is enabled only if both the first and second transaction codes are scanned at the respective second and third times.”

There is nothing in the Final Rejection mailed January 12, 2010 (the “Final Rejection”) that indicates that the Examiner included the underscored limitations in his analysis of the Lewis/Hymel/Melick combination. The explicit claim requirement that “personal bodily access into the physical location or structure is enabled only if both the first and second transaction codes are scanned at the respective second and third times” is a material limitation that must be found in the recited combination to establish a prima facie case of obviousness. The Examiner’s

failure to even address this limitation means that the final rejection of independent claim 47 (and claim 52, which depends therefrom) cannot stand.¹

Moreover, independent claim 47 - as do independent claims 1, 30 and 48 - each explicitly require a single wireless transaction that has the capability of being “partially complete” and then later completed:

Claim 1

at the second time, optically scanning the first transaction code from the visual display of the wireless communication device to permit the personal bodily entry into or through the physical structure to partially complete the wireless transaction; and

at a third time distinct from the first time and the second time, optically scanning a second transaction code from the visual display of the wireless communication device to complete the wireless transaction.

Claim 30

“a second subsystem coupled to the first subsystem capable of:

at a first location and at a first time, optically scanning the first transaction code from the visual display of the wireless communication device to permit personal bodily entry into or through a physical structure to partially complete the wireless transaction; and

at a second location distinct from the first location, and at a second time distinct from the first time and while the wireless transaction remains only partially complete, optically scanning a second transaction code from the visual display of the wireless communication device to complete the wireless transaction.”

Claim 47

“at a second time distinct from the first time, optically scanning the first transaction code from the visual display of the wireless communication device to permit personal bodily entry into the physical location or structure to partially complete the wireless transaction; and

at a third time distinct from the first time and the second time and while the wireless transaction remains only partially complete, optically scanning a second transaction code from the visual display of the wireless communication device to complete the wireless transaction,...

¹ See, Rule 1.104(c)(2) ; *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case”). “[E]very limitation positively recited in a claim must be given effect in order to determine what subject matter that claim defines.” *In re Wilder*, 429 F.2d 447, 450 (CCPA 1970); *See also In re Wilson*, 424 F. 2d 1382, 1385 (CCPA 1970) (“[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.”).

Claim 48

“at a second point in time and while the wireless transaction remains only partially complete, completing the wireless transaction at the point of fulfillment by scanning a two dimensional (2D) image from the wireless communication device.”

The Final Rejection does make reference to the penultimate phrase “to complete the wireless transaction,” but the Examiner’s arguments do not even cite, let alone address, the earlier phrase, namely, the phrases “to partially complete the wireless transaction” or “while the wireless transaction remains only partially complete.” This partial completion of a single wireless transaction is a material claim element.

In particular, the claimed method refers explicitly to a “wireless transaction” that is only “partially complete” (e.g., at a “second time” after a “first transaction code” is optically scanned) and then, subsequently, “complete” (e.g., at a “third time distinct from the first time and the second time” after a “second transaction code is optically scanned”). Diagrammatically, this process can be visualized as follows:

“at a first time”	→	“at a second time”	→	“at a third time”
(transaction begins)		“partially complete”		“complete”

In Lewis, the transaction is not “partially complete” and then later “complete” as “first” and “second” transaction codes are scanned from the device. Rather, a single code is provided to the device and scanned, and then the single transaction is over.

In Hymel, at most there are a series of sequential “transactions” (a coupon is displayed and then redeemed, and then the process repeated for different coupons) but, importantly, each such transaction is completely independent of every other one. There is no single transaction that can be said to be “partially complete” and then “complete” in the manner positively recited.

Indeed, in the Final Rejection the Examiner’s reliance on Hymel recognizes that the reference only provides sequential transactions (i.e., one after the other) when he argues that “Hymel et al teaches a third time distinct (next coupon display and redeem) from the first time and the second time.” (Final Rejection at page 16, emphasis supplied)

Hymel's disclosure of multiple individual transactions (presentment and redemption of a first coupon, presentment and redemption of a second coupon, distinct from the first coupon, etc.) is the exact opposite of the claim requirement of a "transaction [that] remains only partially complete." This is why the Examiner's failure to address the "transaction remains only partially complete" phrase is important. A prima facie case of obviousness requires consideration of every limitation in the cited claim. It cannot be made out by ignoring material claim limitations and then citing to prior art (like Hymel) that does not include the omitted teaching. Stated another way, the Applicants are entitled to have each element in each claim considered for patentability, and the Examiner should not rewrite Applicant's claims to support a rejection.

The "while the [] transaction remains only partially complete" element is not present in the Lewis/Hymel/Melick combination, which at most teaches a system whereby an end user navigates to a web site, purchases a ticket, receives the ticket (that includes a UPC or 2D code) at his/her device or pager, and then presents the code to be scanned from a reader device at a point of entry to the event associated with the ticket. There is just one code, and one scan. Once this scan occurs and the individual enters the event, the individual transaction is over.

The above-identified claims describe a different invention.

2. The final rejection omits any reference to the Mamdani declaration

There is an important piece of evidence in this record that the Examiner did not even mention in the Final Rejection.

The Mamdani declaration was made of record on February 13, 2009, in response to a prior Office action rejection based on Lewis and Hymel (cited currently) and a third reference, Whitworth (U.S. Publication No. 20010034717), which the Examiner had contended taught the "2D image code" aspect of the claims. In response to that earlier rejection, the Applicants submitted the Mamdani declaration to explain why 2D bar codes (such as described in Whitworth) would not have been used to facilitate complex wireless transactions at the time of the present invention. In particular, Mr. Mamdani pointed out that, because of the inherent limitations of mobile devices, mobile device operating systems, and mobile web browser designs, at the time of the invention one of ordinary skill in the pertinent art would not have used 2D

image codes for scanning from a wireless device, such as the Lewis PDA or the Hymel pager. (Mamdani Declaration, at paragraph 8).

The Examiner accepted Mr. Mamdani's argument because in the very next Office action (mailed July 20, 2009), the following paragraph was stated: "Examiner has [] considered the Rule 132 Declaration of Malik Mamdani that was submitted with the communication of February 15, 2009. Whitworth is removed from the Office action." (Office action, July 20, 2009, emphasis supplied).

Nevertheless, in the Final Rejection here, the claims are rejected under the Lewis/Hymel/Melick combination, where Melick is cited solely for its teaching of a 2D bar code. In other words, the Examiner has simply substituted another "2D code" teaching – Melick – for the prior Whitworth teaching which taught the same subject matter. The Final Rejection, however, ignores the Mamdani declaration evidence that one of ordinary skill would not have made the Lewis/Hymel/2D bar code combination at the time of this invention. Indeed, the Examiner has not only ignored the Mamdani declaration in this regard, he has ignored his own prior action (in the Office action mailed July 20, 2009) whereby he "removed" Whitworth from the combination after consideration of that declaration. These inconsistent positions are irreconcilable.

In addition, Mr. Mamdani's declaration also explains that the subject matter of amended claims 1, 30 and 47-48 (use of a 2D image code to facilitate a complex wireless transaction where a first scan "partially" completes the wireless transaction and the second scan then completes that transaction) has been commercially successful. There is no indication that the Examiner has ever considered this evidence, which is of record and should be evaluated as a "secondary consideration" that is probative of non-obviousness if and when the Examiner makes out a prima facie case, which (for the reasons noted above) he has not done.

Because any permissible combination of Lewis, Hymel and Melick does not disclose the subject matter as a whole of any of claims 1, 30 and 47-48, these claims are patentable.

Respectfully submitted,
/David H. Judson/

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